

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:

Jose COSTA REQUENA : Confirmation No.: **2266**
Serial No: **10/023,456** : Examiner: **Mohammad SIDDIQI**
Filed: **October 30, 2001** : Group Art Unit: **2154**

For: **SYSTEM AND METHODS FOR USING AN APPLICATION LAYER CONTROL
PROTOCOL TRANSPORTING SPATIAL LOCATION INFORMATION PERTAINING
TO DEVICES CONNECTED TO WIRED AND WIRELESS INTERNET PROTOCOL
NETWORKS**

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REPLY BRIEF (37 C.F.R. § 41.41)

Sir:

This is a Reply Brief is in response to the Examiner's Answer of April 29, 2008, and in furtherance of the Notice of Appeal filed October 12, 2007, which was submitted along with a Pre-Appeal Brief Request for Review. The Notice of Panel Decision from Pre-Appeal Brief Review mailed November 28, 2007 indicated that the application remains under appeal. This is an appeal from the final Office Action mailed July 17, 2007 rejecting claims 17-21.

REMARKS

This Reply Brief is in response to the Examiner's Answer of April 29, 2008. Appellant continues to assert the arguments presented in the Appeal Brief, and responds to the Examiner's Answer with the discussion presented below.

Appellant had argued, and continues to assert, that the cited references at least fail to disclose or suggest a central server responsive to presence information relating to an invited user registered at a presence server for use in deciding whether content is sent to the invited user, stored or refused, as recited in claim 17. The Office acknowledges on page 3 of the final Office Action that *Dalal* does not disclose deciding whether content is sent to an invited user, stored or refused, and relies upon *Armstrong* for this teaching. The Office asserts that *Armstrong* discloses deciding whether content is sent to an invited user at column 6, lines 48-61. In contrast to claim 17, *Armstrong* only discloses that when a personal communications portal (PCP) (10) receives a presence request it determines whether the requested watched party (13) is available for contact, and if the watched party (13) is unavailable the PCP (10) may inform the watching party (12) of this, or connect the watching party (12) to the watched party (13), or give a list of available communication methods. *See Armstrong* column 6, lines 48-61. However, determining whether the watched party (13) is *available* is not the equivalent of determining whether content is sent, stored or refused, as recited in claim 17. Claim 17 recites that the central server decides whether to send, store or refuse content based on the presence information, however informing one party as to the availability of another party, as in *Armstrong*, is not deciding how to handle content as recited in claim 17.

Furthermore, determining the *best mode of communication* to use based on the watched party's preferences set forth in the rules, and the identity of the watching party is also not the equivalent of determining whether content is sent, stored or refused. *See Armstrong* column 6, lines 54-58. Instead, at the time of the presence request no content has been provided by the watching party, and the determination is merely how the watching party should be connected to the watched party, not how to handle content between the parties. A connection between the parties would have to have been established in order for *Armstrong* to disclose or suggest determining how to handle content between the parties, instead *Armstrong* only addresses

determining whether to connect parties. Without a connection there can be no exchange of content, and logically there can be no determination as to how to handle that content.

The Office also asserts that *Armstrong* discloses deciding to refuse content at column 7, lines 4-16. However, this section of *Armstrong* discusses determining whether the watched party (13) is available for contact, in response to a contact request. In this instance, the PCP (10) uses the stored information about the watched party (13) and the rules (15) to determine whether the watched party (13) is available for contact. For example, if the watched party (13) is online but has configured rules (15) such that no instant messages should be accepted after 9 PM, then the PCP (10) refuses the request. See *Armstrong* column 7, lines 12-14. However, *Armstrong* only discusses refusing the request, i.e. no messages or content have actually been sent, in contrast to claim 17 in which the decision as to whether the content is refused. In *Armstrong*, the connection to the watched party (13) has not been made, instead *Armstrong* only discusses whether or not to connect the watching party to the watched party (13). As discussed above, determining whether to connect one party to another party is entirely distinct from determining how to handle (i.e. store, refuse, forward) content transmitted between the parties, as recited in claim 17. Therefore, for at least this reasons appellant respectfully disagrees with the assertions of the Office in the Examiner's Answer, and respectfully requests withdrawal of the rejections to the claims.

In addition, with respect to claim 18, appellant has pointed out that the filing date of *Dalal* (November 30, 2000) is after the priority date of the present application, November 8, 2000, and therefore is only available as a reference if the provisional application *Dalal* claims priority to supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. § 112, first paragraph. See MPEP § 2136.03; see also MPEP § 706.02(f)(1) (the 35 U.S.C. § 102(e) date of a reference is its earliest effective U.S. filing date taking into consideration any proper benefit claims to prior U.S. applicants under 35 U.S.C. § 119(e) if the prior application properly supports the subject matter used to make the rejection in compliance with 35 U.S.C. § 112, first paragraph). In response to appellant's arguments that the provisional application does not support the subject matter of *Dalal* relied upon by the Office, the Office states that arguments of counsel cannot take the place of evidence in the record. The Office apparently analogizes arguing that a references does not disclose that which it is asserted by the

Office to disclose to evidence related to unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. However, there is no distinction between arguing that a cited reference fails to disclose a claimed feature, and arguing that a prior U.S. provisional application to a cited reference fails to disclose the claimed feature, when the prior U.S. provisional application is required to antedate the priority date of the present application.

In essence, appellant is merely arguing that the claimed invention is patentably distinct from the provisional application, because the provisional application fails to disclose all of the features recited in the claims. This method of overcoming a rejection is expressly permitted by the MPEP. *See* MPEP § 706.02(b) (a rejection based on § 102(e) may be overcome by persuasively arguing that the claims are patentably distinguishable from the prior art). In this instance, it is acknowledged that *Dalal* is not prior art, but for its priority claim to the earlier filed provisional application. Accordingly, the entire disclosure of *Dalal* is not considered prior art, but merely that which is properly supported by the provisional application. As such, appellant is not required to submit an affidavit or declaration stating that subject matter relied upon in *Dalal* is not disclosed in the provisional application, because attorney argument is expressly permitted for such purposes.

In addition, appellant respectfully notes that the examples the Office has provided as attorney statements which must be supported by an appropriate affidavit or declaration are entirely irrelevant to the present situation. The Office has essentially taken the position that any attorney arguments attempting to distinguish claims from cited references must be supported by an affidavit or declaration. There is no requirement for such a position in the case law or section of the MPEP cited by the Office in the Examiner's Answer. Accordingly, appellant respectfully submits that the Office's failure to consider and respond to appellant's arguments in the Appeal Brief with respect to *Dalal* are entirely inappropriate for the reasons stated by the Office. Furthermore, appellant respectfully notes that appellant had previously made a similar argument with respect to claim 17 and *Dalal* in appellant's Amendment filed April 12, 2007. However, in response to appellant's previous argument, the Office never asserted that an affidavit or declaration would have been necessary for an argument based on failure of a prior filed application to properly disclose subject matter relied upon in a later filed application. Instead,

the Office has asserted that such argument is inappropriate for the first time while the application is under appeal. Appellant notes that the Office has been able to avoid the issue of whether the provisional application for *Dalal* properly supports the disclosure in *Dalal* relied upon by the Office by incorrectly asserting that an affidavit or declaration is needed. Accordingly, the Office has completely failed to assert that the provisional application actually does support the subject matter of *Dalal* relied upon by the Office in rejecting the claims, or point to the section of the provisional application which the Office relies upon. Therefore, for at least the reasons presented in appellant's Appeal Brief, appellant respectfully submits that the provisional application does not properly support the subject matter used to make the rejection in compliance with 35 U.S.C. § 112, first paragraph.

Lastly, appellant notes the Office's complete failure to describe or assert where in the provisional application the Office is relying upon for the subject matter discussed in *Dalal*. The Office cannot merely assume that the prior application properly supports the subject matter used to make the rejection, but must in fact provide a showing of the same. *See e.g. In re Wertheim*, 209 USPQ 554, 564 (CCPA 1981); *see also* 37 C.F.R. § 1.104(c)(2) (the particular part of a reference relied upon must be designated as nearly as practical).

Therefore, *Dalal* is not available as a reference against claim 18, because its filing date is after the priority date of the present application, and the disclosure of relied upon in rejecting claim 18 is not supported by the provisional application. *See* MPEP § 2136.03 III. Therefore, for at least this additional reason, claim 18 is not disclosed or suggested by the cited references.

Conclusion

For the reasons discussed above as well as those previously presented in appellant's Appeal Brief, appellant respectfully submits that the rejections of the final Office Action have been shown to be inapplicable, and respectfully requests that the Board reverses the rejections to pending claims 17-21. The undersigned hereby authorizes the Commission to charge Deposit Account No. 23-0442 for any fee deficiency required to submit this Reply Brief.

Respectfully submitted,

Date: 30 June 2008

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